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09/816,091	03/26/2001	Masashi Ota	109073	9597

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EXAMINER

CHERRY, STEPHEN J

ART UNIT PAPER NUMBER

2863

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/816,091

Applicant(s)

MASASHI OTA

Examiner

Stephen J. Cherry

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Information Disclosure Statement***

U.S. Patents 6,018,972 and 6,067,833 included in the Information Disclosure Statement filed 11-5-02, were previously considered, as noted in paper 5 of the application.

### ***Claim Objections***

Claims 2 and 4 are objected to because of the following informalities: The method claim describes "a program" as a method step. The examiner is interpreting "a program" to be computer executable code; although a program may contain instructions to implement a method step, a program itself is not an action performed in a method.

Language such as "executing a program" is suggested.

Additionally, "the determining program" lacks antecedent basis in claim 4.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent 5,682,227 to Taguchi et al.

Claim 1 describes, as disclosed by Taguchi ('227):

1. (Amended) A method for monitoring the status of manufacturing products continuously according to one of a plurality of manufacturing processes, comprising: determining if at least a predetermined manufacturing process for exploiting a property, licensed by a license agreement, out of a plurality of manufacturing processes has been executed, ('227, col. 32, lines 10-26, col. 32, lines 10-26, and col. 36, lines 7-15, process includes outputting image data with particular characteristics to produce particular output of laser onto drum to produce specific product.) storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when it is determined that the predetermined manufacturing process has been executed; and ('227, col. 32, lines 10-26) outputting the stored number of operations executed for manufacturing the products according to the predetermined manufacturing process. ('227, col. 33, lines 7-9 and col. 34, line 53 to col. 35, line 5).

Claim 2 describes, as disclosed by Taguchi ('227):

2. (Amended) The method of claim 1, wherein the determining step comprises: a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom, (Taguchi '227 col. 34, lines 48-52 describe counting pages "book by book". Copies from separate books form different manufacturing processes, which are

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separately counted. This would indicate if copies were made from other books when a particular book is copied.)

Claim 3 describes, as disclosed by Taguchi ('227):

3. (Amended) The method of claim 1, further comprising:

detecting operation of a device operated according to the predetermined manufacturing process; and outputting a predetermined signal, on the basis of which it is determined if the predetermined manufacturing process has been executed. ('227, col. 32, lines 10-26)

Claim 4 describes, as disclosed by Taguchi ('227):

4. (Amended) The method of claim 3, wherein the determining step comprises:

a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing process, or independently therefrom, and (Taguchi '227 col. 34, lines 48-52 describe counting pages "book by book". Copies from separate books form different manufacturing processes, which are separately counted. This would indicate if copies were made from other books when a particular book is copied.)

wherein the storing step comprises: storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when it is determined that the predetermined manufacturing process has been executed according to the determining program, and determined that the predetermined

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manufacturing process has been executed on the basis of the output signal. ('227, col. 32, lines 10-26. These activities are supervised by microcomputer 330, which requires a program to place the count in RAM 332.)

Claim 5 describes, as disclosed by Taguchi ('227):

5. The method of claim 1, further comprising: transmitting the stored number of operations to a communication infrastructure. ('227 col. 34, line 55, describes RAM used to store counts which are later sent to a printer, col. 34, line 55. The communication, as described uses a communication infrastructure, as depicted in figures 57A and 57B. Furthermore, col. 36, lines 13-15 describe the use of this information in the collection of royalties, which would require communication of the data, and the objects used in the communication would be an infrastructure.)

Claim 6 describes, as disclosed by Taguchi ('227):

6. (Amended) An apparatus for monitoring the status of manufacturing products continuously according to one of a plurality of processes, comprising:  
determination means for determining if at least a predetermined manufacturing process for exploiting a property licensed by a license agreement out of a plurality of manufacturing processes has been executed; ('227, col. 32, lines 10-26, col. 32, lines 10-26, and col. 36, lines 7-15, process includes outputting image data with particular characteristics to produce particular output of laser onto drum to produce specific product.)

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storage means for storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when the determination means determines that the predetermined manufacturing process has been executed; and ('227, col. 32, lines 4-9)

output means for outputting the number of operations executed for manufacturing the products according to the predetermined manufacturing process stored in the storage means. ('227, col. 34 line 53 to col. 35, line 5)

Claim 7 describes, as disclosed by Taguchi ('227):

7. (Amended) The apparatus of claim 6, wherein the determination means comprises a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom. (Taguchi '227 col. 34, lines 48-52 describe counting pages "book by book". Copies from separate books form different manufacturing processes, which are separately counted. This would indicate if copies were made from other books when a particular book is copied. These activities are supervised by microcomputer 330, which requires a program to place the count in RAM 332.)

Claim 8 describes, as disclosed by Taguchi ('227):

8. (Amended) The apparatus of claim 6, further comprising: detection means for detecting operation of a device operated according to the predetermined manufacturing process, and outputting a predetermined signal, and wherein the determination means

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determines if the predetermined manufacturing process has been executed, on the basis of the signal output from the detection means. ('227 col. 32, lines 10-26 describes detecting operation of scans of a book document or number of outputs of image data which produce a signal which is counted.)

Claim 9 describes, as disclosed by Taguchi ('227):

9. (Amended) The apparatus of claim 8, wherein the determination means comprises a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom, and wherein the storage means stores the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when the determination means determines that the predetermined manufacturing process has been executed according to the determining program, and determines that the predetermined manufacturing process has been executed on the basis of the signal output from the detection means. ('227 col. 32, lines 10-26 describes detecting operation of scans of a book document or number of outputs of image data which produce a signal which is counted.)

Claim 10 describes, as disclosed by Taguchi ('227):

10. The apparatus of claim 6 further comprising: communication means for transmitting the output of the output means to a communication infrastructure, to which the number of operations stored in the storage means is transmitted. ('227 col. 34, line 55,



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describes RAM used to store counts which are later sent to a printer, col. 34, line 55.

The communication, as described uses a communication infrastructure, as depicted in figures 57A and 57B. The lines depicted in the figures connecting the printer 300 to the microcomputer are interpreted as a "private line" as described on page 16, line 22 of the specification.)

Claim 11 describes, as disclosed by Taguchi ('227):

11. (Amended) The apparatus of claim 6, wherein a license agreement is provided for a property covering the products or a process for manufacturing the products, under the license agreement, a licensee of the agreement holding the apparatus for monitoring the status of manufacturing the products ('227, figs. 57A-57B), and wherein the monitoring apparatus determines if the products or the process made or used by the licensee is covered by the licensed property, on the basis of operation of the predetermined manufacturing process for manufacturing the products ('227, col. 33, lines 41-62".

Claim 12 describes, as disclosed by Taguchi ('227):

12. The apparatus of claim 11, wherein the property to be licensed under the license agreement is at least one of a utility patent, design patent, know how, copy right ('227, col. 30, line 25), and technical assistance.

### ***Response to Arguments***

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Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Cherry whose telephone number is (703) 305-0425. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (703) 308-3126. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0719.

SJC  
January 24, 2003

  
John Barlow  
Supervisory Patent Examiner  
Technology Center 2800